

**REMARKS**

Claims 1-5, 7, 8, 10, 11, 13-38 are now pending in this application. Claims 1-5, 7, 8, 10, 11, and 13-26 are rejected. Claims 6, 9, and 12 are previously cancelled. New claims 27-38 are added. Claims 1, 2, 4, and 10 are amended herein to clarify the invention. Claims 3, 7, 21, and 26 are amended herein for formalistic reasons.

The Federal Circuit has stated that when the art in question is relatively simple, "the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously." *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001 (Fed. Cir. 2001). Applicant hereby respectfully requests that the tests of whether to combine references be especially rigorously applied in the examination of the present application.

Claims 23, 24, and 26 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action states that there is no support in the specification for using a pair of scissors to cut the transfer sheet as required by claims 23 and 26.

Applicant's attorney spoke to Examiner Sue Purvis on April 20, 2006 to discuss the support for using a pair of scissors to cut the transfer sheet. Applicant's attorney specifically pointed out Figure 3 to Examiner Purvis who said that it appears that Figure 3 shows sufficient support for cutting a transfer sheet with a

pair of scissors. Examiner Purvis recommended that Figure 3 should be pointed out in the response to the Office Action. Accordingly, Applicant hereby states that since Figure 3 shows a pair of scissors cutting a transfer sheet, that there is sufficient support for the recitations of claims 23, 24, and 26. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

Claims 1-5 have been rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The Office Action states that it is unclear whether the recitation "including acrylic pressure sensitive adhesive . . . and silicone rubber adhesive" in claims 1 and 2 is part of the claimed invention. Such recitation has been moved to dependent claims and amended as appropriate. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claims 1, 2, 4, 5, 10, and 11 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,601,959 (Brault et al.). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131.

Regarding claim 1, the Office Action states that "[w]hile there is no specific mentioning of the surface tension of the adhesive, it is appreciated that

these types of adhesives by their very nature would have a surface tension where it moves smoothly on the upper surface of the pattern." The Office Action has provided no evidence of this fact. The Office Action also states that "there is nothing in Brault which would lead one to deduce the pattern is not 'able to overlay on another' as required by the claim." However, anticipation requires that every limitation be shown in the prior art and that the Office Action has not met that burden. It is the burden of the U.S. Patent and Trademark Office to show that each and every element of a claim is found in the prior art in order to reject such claim. Thus, claim 1 is patentable over the cited art and notice to that effect is respectfully requested.

Regarding claim 2, the Office Action states that the adhesive used in Brault et al. is capable of being colored by paint. The Office Action has provided no evidence of this fact.

Regarding claim 10, the Office Action did not address the recitation in claim 10 that the adhesive is flexible and has staining properties. Accordingly, it is respectfully requested that claim 10 either be properly rejected or be allowed.

Claim 3 has been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,601,959 (Brault et al.) in view of U.S. Patent No. 6,110,317 (Sandor). To establish a *prima facie* case of obviousness, it is necessary to

show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974); MPEP § 2143.03.

Claim 3 recites forming one or more coating layers on the transferred pattern after the transfer step is carried out. Brault et al. shows in Figure 12 that after the pattern is transferred to the permanent receptor, that the topmost layer in the invention of Brault et al. is the dielectric layer and not the pattern. Accordingly, it is not possible to form one or more coating layers on the transferred pattern disclosed in Brault et al. since those layers would be formed on the dielectric layer and not on the pattern. Accordingly, claim 3 is patentable over the cited art and notice to that effect is respectfully requested.

Furthermore, the Office Action admits that Brault et al. fails to disclose applying a coating layer over the transferred image after the transfer step has been carried out and relies on Sandor for this teaching. The Federal Circuit has stated that the teaching of references can be combined *only* if there is some suggestion or incentive to do so. *See In re Fine*, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988). Brault et al. discloses in column 7, lines 1-6 that the dielectric layer serves as a protective layer over the toned image. There is no indication that additional protection is needed and therefore the necessary incentive to combine Brault et al. and Sandor is missing. Furthermore, *prima facie* obviousness requires an expectation of success and there is no evidence that an additional protective layer in Brault et al. would succeed in achieving any of the objectives

of Brault et al. Thus, *prima facie* obviousness is absent and claim 3 is patentable over the cited art at least for this reason as well.

Additionally, the clear finish layer disclosed in Sandor is a hard layer, as disclosed in column 10, lines 7-9 of Sandor. As described in column 5, lines 20-28 of Brault et al., the permanent receptor in Brault et al. is typically a web or sheet material which can be flexible and which can include textile fabrics. Using a hard layer on a flexible substrate would remove the flexibility of the substrate and the hard layer may even crack if the flexible substrate is bent. Thus, utilizing the clear finish layer disclosed in Sandor in the invention of Brault et al. would create problems with the invention of Brault et al. and therefore the references teach away from combining the clear finish layer disclosed in Sandor with the invention of Brault et al. Thus, claim 3 is patentable over the cited art. Furthermore, claim 3 is further patentable at least for the reason that it depends from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

Claims 7 and 8 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,601,959 (Brault et al.) in view of U.S. Patent No. 3,716,360 (Fukushima et al.). Regarding claim 7, the Office Action states that Brault et al. does not specifically state that the adhesive is transparent or semi-transparent and states that the adhesive in Brault et al. must be transparent or semi-transparent for the indicia to be seen in the final product. However, the

adhesive in Brault et al. is below the indicia and therefore the adhesive does not have to be transparent or semi-transparent for the indicia to be seen in the final product.

Furthermore, the Office Action states that it would be obvious to use an iron to help the transfer as disclosed in Fukushima et al. However, Fukushima et al. does not teach using an iron to transfer a pattern to a substrate by adhering with an adhesive. In column 3, lines 18-40 of Fukushima et al. it is disclosed that an iron is used to transfer a toner image to an adhesive layer. There is no disclosure of a pattern being transferred to a substrate with an adhesive by using an iron. Thus, claims 7 and 8 are patentable over the cited art.

Claims 13 and 15-17 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,601,959 (Brault et al.) in view of U.S. Patent No. 3,334,003 (Edwards). Regarding claim 13, the Office Action states that Brault et al. teaches spraying the adhesive and that Edwards teaches that spraying and using a brush to apply adhesive are functionally equivalent. Brault et al., on column 5, lines 41-47, teaches that the adhesive is sprayed only when other methods are impractical, and therefore teaches that spraying is not equivalent to other coating methods. Furthermore, just because Edwards discloses spraying or using a brush to apply an adhesive does not make spraying and using a brush functionally equivalent.

Regarding claim 15, the Office Action states that "an adhesive would have surface tension greater than that of water." However, claim 15 recites that the surface tension of the upper surface of the pattern is larger than the surface tension of water. Thus, the Office Action has not demonstrated the obviousness of claim 15. Furthermore, the Office Action states that "[t]he adhesive is not meant to flow or move a great deal across a surface, while water would flow easily and not remain in place." If the adhesive is not meant to flow or move a great deal, then that would teach against having a high surface tension of the pattern since a high surface tension would increase the flow of the adhesive. Thus, claim 15 is patentable over the cited art.

Regarding claim 16, the Office Action states that because a brush is being used to spread the adhesive in Brault et al. in view of Edwards, that the adhesive must have a surface tension which enables it to spread. Claim 16 recites that the adhesive moves smoothly on the upper surface of the pattern because of a surface tension of the adhesive. Using a brush does not necessarily require the adhesive to move smoothly because of surface tension and the Office Action has provided no evidence of the contrary. Furthermore, Brault et al. does not disclose or suggest using a brush, as explained above.

Claim 17 recites, *inter alia*, that the remover layer and adhesive are adapted such that the adhesive slips off the remover layer. The Office Action

has cited no reference which discloses or suggest such a limitation.

Accordingly, claim 17 is patentable over the cited art.

Claim 14 has been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,601,959 (Brault et al.) in view of U.S. Patent No. 3,334,003 (Edwards) and further in view of U.S. Patent No. 3,716,360 (Fukushima et al.). Claim 14 is patentable at least for the reason that it depends from a patentable base claim. Furthermore, the Office Action states that it would be obvious to use an iron to help the transfer as disclosed in Fukushima et al. However, Fukushima et al. does not teach using an iron to transfer a pattern to a substrate by adhering with an adhesive. In column 3, lines 18-40 of Fukushima et al. it is disclosed that an iron is used to transfer a toner image to an adhesive layer. There is no disclosure of a pattern being transferred to a substrate with an adhesive by using an iron.

Claim 18 has been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,601,959 (Brault et al.) in view of U.S. Patent No. 3,334,003 (Edwards) and further in view of U.S. Patent No. 6,110,317 (Sandor). The Office Action states that there is no discussion of over-transferring in Brault et al. and Edwards and that it would be obvious to do so in view of Sandor. The Federal Circuit has stated that there must be suggestion or motivation to combine references. *See In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (emphasis added); MPEP § 2143.01. The Office Action has provided no



motivation to perform over-transferring in the inventions of Brault et al.

Accordingly, claim 18 is patentable over the cited art.

Claims 19, 20, and 22 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,601,959 (Brault et al.) in view of U.S. Patent No. 3,334,003 (Edwards) and further in view of U.S. Patent No. 4,994,131 (the '131 patent). Regarding claims 19 and 20, the Office Action states that paint, such as white paint, when used in an adhesive will change the resulting image and that therefore it would be obvious to use it. The Office Action provides no evidence of such a change nor any motivation to combine Brault et al. in such a way. Accordingly, *prima facie* obviousness is absent and claims 19 and 20 are patentable over the cited art. The Office Action also relies on the '131 patent on column 5, line 42 through column 6, line 2 for the proposition that adding paint to the adhesive can result in a smoother finish to the surface. The '131 patent states, on column 5, line 44 to column 6, line 1, that "[b]efore applying the adhesive to the frame, it can be painted with a colored paint, such as red, which provides a smoother finish to the surface." One of ordinary skill in the art would know that the '131 patent discloses adding the paint to the substrate to which the adhesive is added. There is no disclosure of adding paint to the adhesive itself and claims 19, 20, and 22 are therefore patentable over the cited art.

Regarding claim 22, the Office Action states that since a brush is used to apply the adhesive that the same brush can be used to mix the paint with the adhesive. As discussed above, there is no disclosure or suggestion of an adhesive being applied with a brush. Furthermore, the Office Action has cited no art whatsoever that discloses mixing paint with an adhesive by using a brush. The Federal Circuit has stated that there must be suggestion or motivation to combine references. *See In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (emphasis added); MPEP § 2143.01. Merely stating that a brush can be used to mix the paint with the adhesive does not provide the necessary suggestion or motivation to combine the references.

Claims 21 and 25 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,601,959 (Brault et al.) in view of U.S. Patent No. 3,334,003 (Edwards) and further in view of U.S. Patent No. 6,110,317 (Sandor). Claim 21 recites forming one or more coating layers on the transferred pattern after the transfer step is carried out. Brault et al. shows in Figure 12 that after the pattern is transferred to the permanent receptor, that the topmost layer in the invention of Brault et al. is the dielectric layer and not the pattern. Accordingly, it is not possible to form one or more coating layers on the transferred pattern disclosed in Brault et al. since those layers would be formed on the dielectric layer and not on the pattern. Accordingly, claims 21

and 25 are patentable over the cited art and notice to that effect is respectfully requested.

Furthermore, the Office Action admits that Brault et al. in view of Edwards fails to disclose applying a coating layer over the transferred image after the transfer step has been carried out and relies on Sandor for this teaching. The Federal Circuit has stated that the teaching of references can be combined *only* if there is some suggestion or incentive to do so. *See In re Fine*, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988). Brault et al. discloses in column 7, lines 1-6 that the dielectric layer serves as a protective layer over the toned image. There is no indication that additional protection is needed and therefore the necessary incentive to combine Brault et al. and Sandor is missing. Furthermore, *prima facie* obviousness requires an expectation of success and there is no evidence that an additional protective layer in Brault et al. would succeed in achieving any of the objectives of Brault et al. Thus, *prima facie* obviousness is absent and claims 21 and 25 are patentable over the cited art at least for this reason as well.

Additionally, the clear finish layer disclosed in Sandor is a hard layer, as disclosed in column 10, lines 7-9 of Sandor. As described in column 5, lines 20-28 of Brault et al., the permanent receptor in Brault et al. is typically a web or sheet material which can be flexible and which can include textile fabrics. Using a hard layer on a flexible substrate would remove the flexibility of the

substrate and the hard layer may even crack if the flexible substrate is bent. Thus, utilizing the clear finish layer disclosed in Sandor in the invention of Brault et al. would create problems with the invention of Brault et al. and therefore the references teach away from combining the clear finish layer disclosed in Sandor with the invention of Brault et al. Furthermore, claims 21 and 25 are patentable at least for the reason that they depend from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03. Furthermore, regarding claim 25, the Office Action has provided no motivation to color the coating layers. In fact, Sandor discloses "a layer of clear, durable seal coat resin." The Office Action has provided no suggestion or motivation to color any coating layers.

New claims 27-38 have been added. Claims 27-38 are patentable at least for the reason that they depend from a patentable base claim. It is noted, in particular, that claim 29 recites that the adhesive that has been applied to an upper surface of the pattern before the transferring of the pattern to the substrate is put in direct contact with the substrate during transferring. In contrast, Brault et al. discloses applying the adhesive to the substrate, as evidenced by the Abstract of Brault et al. Thus, it would not be possible to have an adhesive that has been applied to a pattern to directly contact the substrate since the substrate is already covered by adhesive before any transferring takes place.

It is also noted that claim 36 recites applying the pattern to a substrate and then separating the transfer sheet from the pattern. In contrast, as can be seen in Figure 11 of Brault et al., the dielectric layer is not removed from the toned image.

It is also noted that claim 37 recites a method "consisting of" certain steps. It is clear from Brault et al. that additional steps, such as putting the adhesive on the substrate, are disclosed. Thus, Brault et al. cannot anticipate nor make obvious claim 37. Accordingly, claims 29, 36, and 37 are further patentable for the above-mentioned reasons.

Support for the claim amendments and for the new claims can be found in the claims as filed, and in Figure 2, Figure 3, Figure 5, Figure 8, Figure 16, Figure 17, Figure 19, and Figure 21. In particular, Figure 21 shows the substrate having adhesive on it before the transferring while Figure 11 does not, demonstrating that the adhesive being on the substrate is merely optional.

Twelve further claims in excess of twenty are added. One further independent claim in excess of three is added. **The fee of \$400.00 for the claims is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.**

Applicant respectfully requests a one month extension of time for responding to the Office Action. **The fee of \$60.00 for the extension is**

**provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.**

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg  
C. Bruce Hamburg  
Reg. No. 22,389  
Attorney for Applicants

By and,

By Ricardo Unikel  
Ricardo Unikel  
Reg. No. 52,309  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340

enc: Form PTO-2038